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10/549,389	09/14/2005	Shigeru Kanaoka	05596/HG	2212

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EXAMINER	
PANDE, SUCHIRA	
ART UNIT	**PAPER NUMBER**
1637	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/549,389	KANAOKA, SHIGERU	
	Examiner	Art Unit	
	Suchira Pande	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *7-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 13-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/4/07;9/14/05*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *20070802* .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Status

1. Examiner thanks the applicant for doing the needful to track down the missing claim amendment. The amendment filed on May 4, 2007 was actually scanned in to IFW on July 30, 2007. Applicant has withdrawn claims 7-12; amended claims 1 and 5; and added new claims 13-20. Accordingly pending claims 1-6, 13-20 will be examined in this action.

Priority

2. Certified English translation copy of the JAPAN 2003-75552 03/19/2003 application as required by 35 U.S.C. 119(b) has been received. Consequently priority of 19 March 2003 is being granted to the claims under consideration.

Information Disclosure Statement

3. The Japanese references cited in the Search Report filed on September 14, 2005 have been considered along with the newly submitted Chinese document. Signed PTO/SB/08B forms are being provided to the applicant with this office action.

Response to Arguments

Response to Arguments re 102(b) rejection of claims 1-5 over Alexander and Raicht (1998) as evidenced by Ultraspec™-II RNA isolation system Biotecx Bulletin No. 28, 1993.

4. Applicant's arguments filed July 30, 2007 have been fully considered but they are not persuasive. Applicant has amended claim 1 to replace the phrase "comprising'" by phrase "consisting essentially of". For the purposes of searching for and applying prior

art under **35 U.S.C. 102** and **103**, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See MPEP 2111.03 Transitional Phrases [R-3]. See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase 'consisting essentially of' for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See MPEP 2111.03 Transitional Phrases [R-3].

Applicant argues that Alexander and Raicht teach separating cell components by using centrifugation. Specification does not provide any indication to one of ordinary skill what applicant means by phrase "separating cell components". Absent any definition Examiner is interpreting "cell components" to mean various organelles such as nuclei, golgi bodies, mitochondria, endoplasmic reticulum etc i.e. the components that are part and parcel of biological cells. So a method of separating cell components would mean methods of separating various organelles such as nuclei, golgi bodies, mitochondria, endoplasmic reticulum etc from the rest of the material that comprises a cell.

Alexander and Raicht do not teach separating cell components and using the specific isolated component such as nuclei or mitochondria for isolation of RNA, rather they teach isolation of Total RNA (see title). The step applicant is referring to is used to separate particlulate matter and some bacteria (see page 2653, par. 2 under Purification of total RNA). Hence method of Alexander and Raicht is not used for "separating cell components" by centrifugation. Furthermore the first step is being

conducted in presence of solution containing EDTA. EDTA is a chealator that is well known and routinely used by one of ordinary skill in the art to inhibit RNAse activity. Therefore the prior art 102 (b) rejections are being maintained.

Response to Arguments re 103(a) rejection of claim 6 over Alexander and Raicht (1998) in view of Sano et al. (1995)

5. Applicant's arguments filed July 30, 2007 have been fully considered but they are not persuasive. Applicant is arguing that Alexander and Raicht do not teach tumor marker COX-2. Indeed this is the case and that is precisely the reason why Examiner has rejected claim 6 over Alexander and Raicht in view of Sano et al. Sano et al. teach tumor marker COX-2. Since rejection over Alexander and Raicht are being maintained. The rejection of claim 6 over Alexander and Raicht in view of Sano et al. is also being maintained.

Claim Rejections - 35 USC § 112

6. Claims 1 and 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 1 and 5 to read a method for diagnosing colon cancer "consisting essentially of". The change is being done presumably to circumvent the prior art cited. Applicant has not specified in the specification what the basic and novel characteristics are of this method. See MPEP 2111.03 Transitional Phrases [R-3]. See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase 'consisting essentially of' for

purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.").

Claim interpretation

7. In the amended method claim phrase "consisting essentially of". For the purposes of searching for and applying prior art under **35 U.S.C. 102** and **103**, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 13-14, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander and Raicht (1998) Digestive Diseases and Sciences Vol. 43 No. 12 pp 2652-2658 as evidenced by Ultraspec^{TM}-II RNA isolation system Biotecx Bulletin No. 28, 1993.

Regarding claim 1, Alexander and Raicht teaches a method for preparing a sample to extract RNA (see title where Total RNA purification from Human stool sample is taught) used in a tumor marker detecting method (see abstract where RNA isolated from human stool shown to be useful for detecting human mRNA is taught) for

diagnosing colon cancer (See page 2652 par.1-2, where colon neoplasia and methods of diagnosing it are taught) consisting essentially of:

a) homogenizing a collected biological (human stool) sample in the presence of an RNase inhibitor (Ultraspec II reagent from Biotecx Laboratories contains chaotropic agent 14 M guanidium salt that are potent inhibitors of Rnase), to prepare a suspension thereof (See page 2653 Materials and Methods par. 2-4 under Purification of total RNA from stool samples); without separating cell components from the biological sample (the method taught by Alexander and Raicht directly homogenizes the stool without separating cell components see page 2653 where frozen piece of stool is made into a slurry (in a solution containing EDTA which is a well known chelating agent routinely used by one of ordinary skill in the art to inhibit RNAse activity) and particulates are removed from the suspension by decantation followed by lysis using the Ultraspec II reagent from Biotecx Laboratories).

Thus, claim 1 is anticipated by Alexander and Raicht.

Regarding claims 2 and 17, Alexander and Raicht teach wherein the collected biological sample is frozen (see page 2653 par. 2 under Purification of Total RNA from Stool Samples, where freezing for Stool sample in Liquid Nitrogen is taught).

Regarding claims 3 and 18, Alexander and Raicht teaches wherein the Rnase inhibitor is guanidine thiocyanate (Alexander and Raicht teach use of Ultraspec II reagent, a single step RNA purification from Biotecx Laboratories. This reagent contains 14 M solution of guanidine salts. The formulation is based on a method of Chomczynski

and Sacchi that uses guanidinium thiocyanate-phenol-chloroform for RNA isolation. See Biotecx Bulletin No:28, 1993, Introduction and Reference no 3.).

Regarding claims 4 and 19 Alexander and Raicht teach wherein the biological sample is feces (see Title where stool samples ie. feces is taught).

Regarding claim 5, Alexander and Raicht teach a tumor marker detecting method for diagnosing colon cancer consisting essentially of :

a) homogenizing a collected biological sample in the presence of an RNAse inhibitor to prepare a suspension, without separating cell components from the biological sample (see page 2653 par. 2 under purification of total RNA where suspension (slurry) formation is taught in a solution containing EDTA (EDTA is an RNase inhibitor is evidenced by Gamble et al. (see page 372 abstract J. Parasitol. 67(3) 1981) 372-377). This suspension is further homogenized in presence of Ultraspec II reagent from Biotecx Laboratories (see page 2653 par. 3). Note no separation of cell components from the biological sample is done in this method total cell lysis is performed.;

b) extracting RNA from the sample obtained from step (a) to provide extracted RNA (see page 2653 section titled: Purification of total RNA from stool samples) (see page 2653 par. 3-4 where RNA extraction is taught);

c) carrying out reverse transcription on the extracted RNA from step (b) to provide cDNA (see page 2654 par. 3-4 where RT-PCR is taught);

d) amplifying the cDNA from step (c) (see page 2654 par. 5-6 where PCR amplification of cDNA is taught); and

e) detecting the amplified cDNA from step (d) (see page 2654 par. 7 and Results par. 3 where detection of amplified cDNA by gel electrophoresis is taught).

Regarding claim 13, Alexander and Raicht teach wherein the biological sample comprises microorganisms (see page 2656 par.1 where presence of intestinal bacteria in the human stool is taught. by this teaching Alexander and Raicht teach wherein the biological sample (stool) comprises microorganisms).

Regarding claim 14, Alexander and Raicht teach wherein in step b) whole RNA is extracted from the sample obtained from step a) without separating RNA derived from human cells from RNA derived from bacteria (see title of section TOTAL RNA extraction—this inherently teaches no separation of RNA was done. All the RNA from any kind of human or bacterial cell that was present in the sample was extracted.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander and Raicht (1998) Digestive Diseases and Sciences Vol. 43 No. 12 pp 2652-2658 as evidenced by UltraspecTM-II RNA isolation system Biotecx Bulletin No. 28, 1993 in view of Sano et al. (1995) Cancer Research 55: 3785-3789.

Regarding claim 6, Alexander and Raicht teach method of claim 1 but do not teach wherein the tumor marker is COX-2.

Regarding claim 20, Alexander and Raicht teach wherein the collected biological sample is frozen (see page 2653 par. 2 under Purification of Total RNA from Stool Samples, where freezing for Stool sample in Liquid Nitrogen is taught).

Regarding claim 20, Alexander and Raicht teaches wherein the Rnase inhibitor is guanidine thiocyanate (Alexander and Raicht teach use of Ultraspec II reagent, a single step RNA purification from Biotecx Laboratories. This reagent contains 14 M solution of guanidine salts. The formulation is based on a method of Chomczynski and Sacchi that uses guanidinium thiocyanate-phenol-chloroform for RNA isolation. See Biotecx Bulletin No:28, 1993, Introduction and Reference no 3.).

Regarding claim 20 Alexander and Raicht teach wherein the biological sample is feces (see Title where stool samples ie. feces is taught).

Regarding claim 6, Sano et al. teach wherein the tumor marker is COX-2 (see abstract where COX-2, a colon cancer marker is taught)

It would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to use COX-2 tumor marker taught by Sano et al. in the method of Alexander and Raicht for diagnosing colon cancer. The motivation to do so is provided by Sano et al.

Sano et al. show enhanced expression of the COX-2 gene in colon cancer tissues. They state " Moreover, the immunoreactive COX-2 was abundant in colonic cancer cells in our study. COX-2 may assume an important role in the activation

pathways by which carcinogens can be converted to the reactive intermediates that mutate DNA. These findings suggest that COX-2 induced by stimulation of chemical substances, cytokines, and growth factors may have a role in the initiation, promotion, and maintenance of colorectal cancers" (see page 3788 last 2 paragraphs)

12. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander and Raicht (1998) Digestive Diseases and Sciences Vol. 43 No. 12 pp 2652-2658 as evidenced by UltraspecTM-II RNA isolation system Biotecx Bulletin No. 28, 1993 in view of Godfrey et al. (US Pat. 7101663 B2 issued September 5, 2006 filed on March 4, 2002).

Regarding claim 15, Alexander and Raicht teach the method of claim 5 and teach RT PCR. But do not teach wherein in step d) amplifying the cDNA from step c) is carried out by a nested PCR.

Regarding claim 15, Godfrey et al. teach wherein in step d) amplifying the cDNA from step c) is carried out by a nested PCR (see col 15 line 61 where nested PCR is taught).

Regarding claim 16, Godfrey et al. teach, wherein the amplification is carried out by a PCR and a first round of the PCR is executed for 20 cycles (see col. 20 lines 19-20 where Godfrey et al. teach PCR is carried out in two 20-cycle steps. Thus Godfrey et al. teach wherein the amplification is carried out by a PCR and a first round of the PCR is executed for 20 cycles).

It would have been prima facie obvious to one of ordinary skill in the art to practice the method of Godfrey et al. in the method of Alexander and Raicht at the time the invention

was made. The motivation to do so is provided to one of ordinary skill in the art by Godfrey et al. who state " Quantitative RT-PCR is a sensitive technique and is particularly useful for the analysis of samples containing limited amounts of nuclei acids, such as in clinical tissues------. When quantitating these small amounts of RNA and/or very low abundance mRNA species, obtaining maximum sensitivity from a quantitative RT-PCR is extremely important. While consecutive rounds of nested PCR are often used to obtain maximum sensitivity, this is difficult to achieve and still maintain accurate quantitation. Furthermore, multiple rounds of PCR increase the risk of contamination, a serious problem when working at desired sensitivity levels. One tube RT-PCR reduces the risk of contamination ------because the reaction tubes are never opened. Theoretically, a one tube procedure should have the same sensitivity as a two step approach (separate RT followed by PCR) but in practice this is not the case". (see col. 15 lines 28-43). They go on to list out the reasons why this is the case. Finally they state "In a two –step or **nested RT-PCR procedure**, specificity can be achieved with the use if hot-start PCR and a primer set 5' upstream from the RT primer. However, this is not the case in a one –tube procedure unless one is willing to open the reaction tube to add new primers (thus making it a one –tube but two step procedure). It has been hypothesized that by using an external RT primer and keeping the RT and PCR primers separated during the RT step, PCR specificity and therefore sensitivity in a one –tube RT-PCR should be maintainable------Here, a modified one –tube RT-PCR assay that greatly increases sensitivity and can be used for quantitative RT-PCR----is presented." (see col 15 lines 61- col. 16 line 5). Thus explicitly teaching to one of ordinary skill that

by using this modified method one can perform ***nested PCR*** in one tube closed format and at the same time have a sensitive quantitative RT-PCR.

Conclusion

13. Claims 1-6 and 13-20 under consideration are rejected over prior art.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suchira Pande whose telephone number is 571-272-9052. The examiner can normally be reached on 8:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Suchira Pande
Examiner
Art Unit 1637

JEFFREY FREDMAN
PRIMARY EXAMINER